

REMARKS

The present amendment has been filed in response to the final Office Action dated June 5, 2007. The present amendment is being filed concurrently with a Request for Continued Examination (RCE). In the present amendment, Claims 1, 4, 10, and 20 have been amended; Claims 11-19 have been canceled; and new Claims 21-24 have been added. Thus, Claims 1, 4-6, 10, and 20-24 are pending in the present application.

In the final Office Action, Claim 10 was rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,137,517, issued to Loney et al. ("Loney"). Claims 1 and 4-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Loney in view of U.S. Patent No. 4,057,186, issued to Hedger ("Hedger"), and further in view of U.S. Patent No. 6,533,772, issued to Sherts et al. ("Sherts"). Claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Loney in view of Hedger. Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Loney in view of Sherts.

Claim Rejections Under 35 U.S.C. § 102

Claim 10 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Loney. Applicants respectfully traverse the rejection of this claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). For at least the following reasons, applicants respectfully assert that the claimed combination of features recited in Claim 10 is neither taught nor rendered obvious by Loney.

Claim 10 has been amended to recite that the slider is U-shaped and includes an open ended channel and a closed end that forms an engagement surface. Claim 10 has been further amended to recite that the open ended channel of the U-shaped slider receives a portion of the

wire when fitted in the open ended channel. As admitted in paragraph 9 of the Office Action, Loney fails to disclose a U-shaped slider. Moreover, paragraph 9 of the Office Action admits that Hedger fails to disclose a U-shaped slider. Applicants assert that Sherts also fails to teach a U-shaped slider as recited in Claim 10. Specifically, the slider 106 of Sherts does not include an open ended channel that receives a portion of the wire when fitted in the U-shaped channel of the body. See Figures 12a-12c of Sherts.

Therefore, it is clear that Loney, and the prior art cited against the other claims of the present application, fail to disclose or render obvious the recited combination of features of amended Claim 10. Thus, applicants respectfully request withdrawal of the pending rejection under 35 U.S.C. § 102(b) with regard to Claim 10.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1 and 4-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Loney in view of Hedger, and further in view of Sherts. Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Loney in view of Hedger. Claim 20 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Loney in view of Sherts. Claim 11 has been canceled, thus rendering the rejection to this claim moot. Applicants traverse the rejections of the remaining claims.

Under Section 103, the *prima facie* case of obviousness is established only if the cited references, alone or in combination, teach each of the limitations of the recited claims. *In re Bell*, 991 F.2d 781 (Fed. Cir. 1993). Applicants respectfully assert that the combinations proposed by the Office Action fail to teach every element of the claims. Additionally, applicants respectfully assert that neither the cited prior art nor common knowledge to one of ordinary skill in the art would render obvious the inventions recited in the claims.

Independent Claim 1

The Office Action contends that Loney discloses all of the claimed features except for a U-shaped slider and a tongue supported in the U-shaped channel including a first engagement surface positioned above a bottom surface of the U-shaped channel that allows the wire to be compressed against the first engagement surface and the second engagement surface of a U-shaped slider having a closed end. The Office Action contends that Hedger discloses a tongue (19) supported in a channel (15), including a first engagement surface or the "upper-surface of the tongue" positioned above a bottom surface of the channel, and a second engagement surface or "under-surface of the slider" that receives a wire (23) that is inserted in the channel and compresses the wire against the first engagement surface of the tongue. The Office Action also contends that Sherts discloses a U-shaped slider. The Office Action then reaches the conclusion that it would have been obvious to one having ordinary skill in the art to modify the invention of Loney to include the tongue of Hedger and the U-shaped slider of Sherts to arrive at applicants' claimed invention.

Claim 1 has been amended to clarify that the body channel is open ended instead of U-shaped. Applicants believe that the invention of Claim 1 does not need to be limited to a channel that is U-shaped but instead can be any geometry that is open ended. Claim 1 has also been amended to recite that 1) the opening of the channel extends along the entire length of the body portion for allowing the wire to be side-loaded into the channel, and that 2) the end that forms a second engagement surface receives the wire when the wire is side-loaded in the channel. Claim 1 further requires that the wire is compressed between the first engagement surface of the tongue and the second engagement surface of the slider so that rotation of the body portion applies torque to the wire.

Hedger is directed to a wiring pen that comprises a body 10 formed with a bore 15 extending therethrough and a slot 14. The slot 14 carries a slider 16 that is formed with a tongue 19. Instead of being side-loaded, Hedger includes a hole 20 at the interface between the tongue 19 and the slider 16 for allowing a wire from a reel 21 carried at the end of the body 10 to be threaded therethrough. See Figs. 4 and 6. As such, the configuration of the slider prohibits any possible side-loading of a wire.

Thus, if Loney is modified by the teachings of Hedger such that either the slider 16 of Hedger is utilized or that the slider 16 of Loney is modified to include the tongue 19 of Hedger, as proposed by the Office Action, the resulting combination would prohibit the wire from being side-loaded, as specified by Claim 1, while still meeting the remaining requirements of Claim 1, namely, that the wire is compressed between the first engagement surface of the tongue and the second engagement surface of the slider so that rotation of the body portion applies torque to the wire. Further, Sherts fails to teach the ability for the wire to be side-loaded, and therefore, fails to correct the deficiencies of Hedger.

Therefore, the proposed combination of Loney, Hedger, and Sherts fails to teach or render obvious each and every element of Claim 1. Accordingly, applicants assert that a *prima facie* case of obviousness has not been established. Therefore, applicants respectfully request the pending rejection of Claim 1 under 35 U.S.C. § 103(a) be withdrawn. Further, applicants respectfully request withdrawal of the pending rejections under 35 U.S.C. § 103(a) of Claims 4-6, which depend from Claim 1.

Independent Claim 20

Claim 20 has been rewritten into independent form. Claim 20 is directed to a wire torquing device. The Office Action states that Loney teaches each of the elements of Claim 20 except for the U-shaped channel including a fixed wedge positioned on one of the side walls of

the channel. The Office Action contends that Sherts teaches an analogous device that comprises a channel (100b) that includes a wedge (104) fixed in a vertical direction and positioned on a side wall of the channel. The Office Action then reaches the conclusion that it would have been obvious to one of ordinary skill in the art to combine Loney with Sherts to arrive at applicants' claimed invention. Applicants respectfully disagree with such a conclusion.

Claim 20 recites a body having an open U-shaped channel that includes a pair of side walls, a bottom surface and a fixed wedge positioned on one of the side walls of the U-shaped channel. The Office Action contends that Sherts teaches a wedge (104) fixed in a vertical direction and positioned on a side wall of the channel (100b). Applicants disagree with the Office Actions' characterization of element (104) in Sherts. Specifically, the Office Action contends that element (104) is a wedge. However, nowhere in Sherts does it illustrate or describe element (104) as a wedge. Instead, Sherts describes element 104 at Col. 10, lines 9-13, as follows: "In FIGS. 12a-12c, a section of the housing adjacent the guide wire passage receives a clamp pad 104 and a slide button 106 with angled cam surface 106a. The clamp pad moves perpendicular to the passage axis x-x' to grip and ungrasp a wire." (Emphasis added.) As admitted in the Office Action, Loney fails to correct the deficiency of Sherts.

Additionally, Claim 20 recites that "the slider includes an engagement surface facing the wedge that is longitudinally movable towards and away from the wedge to pinch the wire against the wedge." As best shown in FIGURES 12a-12c of Sherts, the wire is not pinched between the slider 106 and clamp pad 104. Instead, the wire is pinched between clamp pad 104 and the bottom surface of the channel 100b. As admitted in the Office Action, Loney fails to teach a wedge; therefore, Loney fails to correct the deficiency of Sherts.

Since Loney and Sherts, either alone or in combination, fail to teach a U-shaped channel that includes a fixed wedge positioned on one of the side walls of the U-shaped channel and that

the engagement surface of the slider pinches the wire against the wedge, the combination of Loney and Sherts proposed by the Office Action fails to teach each and every recited element of Claim 20. Accordingly, applicants assert that a *prima facie* case of obviousness has not been established. Therefore, applicants respectfully request the pending rejection of Claim 20 under 35 U.S.C. § 103(a) be withdrawn.

New Claims 21-24

New Claims 21-24 have been added to particularly point out and distinctly claim the novel aspects of the present invention. Applicants respectfully assert that the newly submitted claims recite combinations of features neither taught nor rendered obvious by the prior art. Accordingly, applicants respectfully submit that new Claims 21-24 are in condition for allowance.

CONCLUSION

In light of the foregoing amendments and remarks, applicants submit that all of the claims of the present application are in condition for allowance. Thus, applicants respectfully request the allowance of all pending claims. If any further questions remain, the Examiner is invited to telephone applicant's attorney at the number listed below.

Respectfully submitted,

CHRISTENSEN O'CONNOR
JOHNSON KINDNESS^{PLLC}



Brandon C. Stallman
Registration No. 46,468
Direct Dial No. 206.695.1708

BCS:BCS/pww

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100